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09/641,101 08/17/00 CARLSON

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EXAMINER

004955 QM02/0417  
WARE FRESSOLA VAN DER SLUYS &  
ADOLPHSON, LLP  
BRADFORD GREEN BUILDING 5  
755 MAIN STREET, P O BOX 224  
MONROE CT 06468

KEASEL, E  
ART UNIT

PAPER NUMBER

3754  
DATE MAILED:

04/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/641,101

Applicant(s)

CARLSON ET AL.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Reissue Applications*

1. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

2. Claims 10-17, 19, 20, 22, and 24-42 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

- i) the connector on the insert member;
- ii) the insert member attached to the valving member;
- iii) the insert member attached to the valve seat;
- iv) the insert member having a parabolic opening;
- v) the valving member being formed from brass or stainless steel;
- vi) the insert members made of plastic;
- vii) the inserts having a diameter corresponding to the diameter of the bore of the valving member; and
- viii) the valving member and connectors of the insert members comprising cooperating legs and pockets;
- ix) a portion of the valve seat extending across the fluid passage and having an elongate opening.

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3. Claims 18, 21, and 23 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During prosecution of US Patent Application Number 09/084,698 (US Patent Number 6,039,304, the basis of the present reissue application), the following subject matter was introduced into independent claims 1, 15, and 22 (renumbered claims 1, 4, and 6 upon allowance) and is subject matter that is surrendered:

“wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”

Claims 18, 21, and 23 are broader in scope than the patented claims because no particulars of the attachment are claimed. The claim limitation “attachable across said fluid passage” is broader than the detailed recitations of the groove and retaining ring and represent an

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improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10-17, 19, 20, 22, and 24-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following subject matter is not supported in the specification.

- i) the connector on the insert member;
- ii) the insert member attached to the valving member;
- iii) the insert member attached to the valve seat;
- iv) the insert member having a parabolic opening;
- v) the valving member being formed from brass or stainless steel;
- vi) the insert members made of plastic;
- vii) the inserts having a diameter corresponding to the diameter of the bore of the valving member; and
- viii) the valving member and connectors of the insert members comprising cooperating legs and pockets; and

ix) a portion of the valve seat extending across the fluid passage and having an elongate opening.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Scaramucci (US Patent Number 3,542,338).

Scaramucci discloses a ball valve for providing a plurality of predetermined flow conditions therethrough comprising a housing (12) having upstream (24) and downstream (22) passages, valve seat (60), and a valving member (34) having a bore (36). The upstream passage, downstream passage, and bore define a fluid passage through the housing. A portion of the valve seat extending across the fluid passage has an elongate opening (36b). The valve seat is detachable and replaceable with other valve seats, such as the valve seat of Fig. 1C.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 18, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaramucci ('338).

Scaramucci discloses a ball valve for providing a plurality of predetermined flow conditions therethrough comprising a housing (12) having upstream (24) and downstream (22) passages, valve seat (60), and a valving member (34) having a bore (36). The upstream passage, downstream passage, and bore define a fluid passage through the housing. A portion of the valve seat extending across the fluid passage has an elongate opening (36b). The valve seat is detachable and replaceable with other valve seats, such as the valve seat of Fig. 1C.

Scaramucci discloses the inserts as the valve seats rather than two distinct elements. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the valve seat as two distinct parts (the valve seat and the insert), since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177 (Bd PatApp&Int 1969).

Scaramucci also fails to disclose the material selection for the valving member and inserts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the valving member of brass or stainless steel and the inserts of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (CCPA 1960).

***Allowable Subject Matter***

10. Claims 1-9 are allowed.

***Response to Arguments***

11. Applicant's arguments filed 19 March 2001 have been fully considered but they are not persuasive.

Applicant argues that the original disclosure fully supports all 33 claims copied from Marandi ('890). However, of the nine limitations cited by the examiner as not being supported, applicant clearly admits that six are not supported in the original disclosure. The argument that a claim limitation should be considered as disclosed if it not disclosed (but considered obvious) is not persuasive.

Applicant argues that "the connector on the insert member" should be considered as disclosed since applicant's flange, "in conjunction with another means", performs an equivalent function. There are two problems with this argument. One, the unnamed "another means" of



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applicant does not appear to be on the insert member. Two, disclosing what applicant views as an equivalent means is not disclosing “the connector on the insert member”.

Applicant argues that ‘890 does not disclose “the insert having a parabolic opening”. The examiner disagrees. ‘890 clearly discloses a parabolic opening for the insert in both the specification and figures. See, for example, Figs. 4, 5, and 7 and column 5, line 26, column 6, lines 6 and 67, and column 7, lines 28 and 35, of the specification. Applicant discloses a pie-shaped wedge (see Figs. 3 or 5), the curved portion of the wedge is circular, not parabolic.

Applicant appears to argue that “the inserts having a diameter corresponding to the diameter of the bore of the valving member” should be considered as disclosed because applicant’s insert is larger than the bore diameter and thus has “a diameter” arbitrarily chosen that would correspond to the bore diameter. This claim limitation can not be read that broadly because it is presented in dependent claim 26, which must further limit independent claim 18. The independent claim recites the insert and the insert must inherently correspond or be larger than the bore diameter. To further limit claim 18, claim 26 must be read as a distinct diameter on the insert rather than an arbitrarily chosen diameter.

Applicant argues that recapture should not apply in a reissue application that attempts to provoke an interference. The examiner can find nothing in the MPEP or applicant’s arguments to suggest that this should be the case.

Applicant appears to argue that “reasons” (presumably grounds) of rejection have not been supplied and that applicant has been denied “due process”. The examiner disagrees. The grounds of rejection have been clearly stated above and in the action mailed 19 December 2000.


***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (703) 308-2582. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0861.

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ek  
April 4, 2001

  
KEVIN SHAVER 4/10/01  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700